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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Ryan

MAILED: May 1, 2003

Opposition No. 150,749

Recoton Corporation

v.

Advent Networks, Inc.

Before Quinn, Chapman, and Drost, Administrative Trademark Judges.

By the Board.

An application was filed by Advent Networks, Inc. to register the mark ADVENT NETWORKS for computer software and hardware for specialized telecommunications purposes and various types of fiber optic network equipment in International Class 9.[1]

A notice of opposition was filed by "Recoton Corporation, a New York corporation, Parent company for Recoton Audio Corporation."[2] The notice of opposition consists in its entirety

[1] Application Serial No. 76/033,895, filed April 6, 2000. This application includes goods and services in International Classes 9 and 38. The opposition is against only the International Class 9 goods.

[2] Having considered the notice of opposition, the cover letter submitted in connection therewith, and the submission of an opposition filing fee to cover only one party opposer and only one class of goods, the Board has treated the notice of opposition as filed in the name of the parent entity "Recoton Corporation." Recoton Audio Corporation is not named as an opposer in this case.

Recoton Corporation, the parent entity, has clearly identified itself as opposer in the caption of the notice of opposition, in the signature block thereto, in the heading of the cover letter submitted in connection therewith, and in the preamble of the notice of opposition.

of the statement that "[t]he above-identified Opposer believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same" followed by:

> The grounds for opposition are as follows:
>
> 1. There would be a likelihood of confusion between the Applicant's goods of interest applied for under the proposed application, and Opposer's goods already registered under United States Patent and Trademark Registration No. 1008947.
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> 2. Opposer's trademark has gained prominence in the United States and worldwide for its goods of interest as can be seen by the attached list of Recoton Corporation's trademarks (attached hereto as Exhibit A and made a part hereof). (Emphasis in original)

In Exhibit A, opposer lists, among many other worldwide registrations, U.S. Reg. No. 1,008,947[3] and application Serial No. 76/278,714[4] as opposer's ADVENT trademarks in the United States. The insufficiency of this pleading will be discussed later in this order.

Applicant filed an answer denying the salient allegations of the opposition and asserting various "affirmative defenses," including estoppel, laches, and that "applicant's use and

[3] Reg. No. 1,008,947 is for the mark ADVENT covering various types of audio equipment and tape decks in International Class 9.

[4] Subsequent to the time of filing the notice of opposition, application Serial No. 76/278,714 matured into Registration No. 2,558,737. It is noted, however, that opposer has not pleaded likelihood of confusion between the applicant's mark and this registered mark. This registration is for the mark ADVENT covering various types of home and mobile audio, video, and radio equipment, and loudspeakers in International Class 9.

registration of the ADVENT NETWORK mark cannot . . . dilute or tarnish any rights of opposer."[5]

This case now comes up on applicant's motion for summary judgment (filed October 31, 2002).[6] The motion for summary judgment has been briefed and the Board has considered all of the parties' arguments and evidentiary submissions.

In order to determine the summary judgment motion, the pleadings must be reviewed by the Board. Upon such review, it is clear that the notice of opposition refers to a likelihood of confusion between the goods, and does not include an allegation of priority. Thus, it does not include a proper pleading of likelihood of confusion of the marks or priority, both of which are essential elements to any case filed under Trademark Act Section 2(d). Nonetheless, while it is clear that opposer's pleading is legally deficient, we have considered opposer's notice of opposition as a claim of likelihood of confusion under Section 2(d) of the Trademark Act in order to determine opposer's summary judgment motion.

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[5] The current notice of opposition does not include a dilution claim; and it is not an "affirmative defense" to assert there is no dilution or tarnishment.

[6] The summary judgment papers have been filed under the case caption of "Recoton Audio Corporation v. Advent Networks." As explained earlier herein, the opposer is Recoton Corporation. The parties are advised that the proper caption is "Recoton Corporation v. Advent Networks, Inc." and this caption should be used on all papers filed herein.

In reviewing the record, we note that in a prior order (on December 12, 2002) the Board admonished opposer's attorney for inappropriately serving opposer's motion for summary judgment directly on applicant, instead of on applicant's counsel of record as required by Trademark Rule 2.119. It is suggested that opposer's attorneys familiarize themselves with proper Board practice and procedure.

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). A fact is genuinely in dispute if the evidence of record is such that a reasonable factfinder could return a verdict in favor of the nonmoving party. *Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 248 (1986). Furthermore, in deciding a motion for summary judgment, the Board may not resolve an issue of fact; it may only determine whether a genuine issue of material fact exists. *See Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all reasonable inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great American Music Show, Inc.,* 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.,* 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In support of its motion for summary judgment, opposer argues that it is entitled to summary judgment because its ADVENT mark is strong and is entitled to broad protection; that its mark has been in use since 1969; that its mark is "well-known in the home and mobile consumer [electronics] market" (Affidavit of Loan Kennedy, Vice President of Recoton

Corporation, attached as Exhibit C to opposer's motion, paragraph 8); and that opposer should be permitted to update its goods under its registered ADVENT mark to reflect advances in modern technology. Furthermore, opposer asserts that the channels of trade are identical inasmuch as opposer "believes" that the parties' goods "are both marketed and sold in the original equipment ('OEM') market" and to end users in the "home consumer" market. (Kennedy Affidavit, paragraphs 10 and 11). Opposer claims prior rights through its use of the ADVENT mark by its subsidiary Recoton Audio Corporation and registered under Reg. Nos. 1,008,947 and 2,558,737. (Kennedy Affidvait, paragraphs 2 and 3).

In its response, applicant contends that opposer has not carried its burden for obtaining summary judgment insofar as opposer has failed to establish the absence of any genuine issues of material fact. Applicant argues that there is no likelihood of confusion, contending primarily that the parties' marks and goods are different; that opposer's mark is not strong given the existence of numerous third-party marks that include the ADVENT term[7]; and that the channels of trade of the parties'

[7] See Declaration of Catherine Rapinett, Administration Manager for Advent Networks, Inc., with exhibits, which include copies of USPTO Trademark Electronic Search System ("TESS") database records of third-party registrations and/or applications containing the term "ADVENT" and copies of documents retrieved from a search of the Internet, all offered to show the existence of third-party marks containing the "ADVENT" term in a wide range of consumer-oriented fields, including the fields of computer software and computer technology. It is noted that such evidence is probative on summary judgment when submitted by the nonmovant to establish the presence of a genuine issue of material fact as to third-party use. Of course, such registrations do not prove actual use. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973); and *Alpha Industries, Inc. v. Alpha Microsystems,* 223 USPQ 96 (TTAB 1984).

goods differ markedly inasmuch as applicant's goods and services are directed to cable companies engaged in the field of providing broadband Internet telecommunication services and are not sold directly to consumers. See Declaration of Steven Burt, Chief Financial Officer of Advent Networks, Inc., paragraph 3.

Based on the record now before us, we conclude that summary judgment is not appropriate in this case. At a minimum, we find that genuine issues of material fact exist as to the strength of opposer's mark, the relatedness of the parties' goods, the channels of trade, and the class of purchasers of the parties' goods.[8]

Accordingly, opposer's motion for summary judgment is denied.[9]

OPPOSER ORDERED TO FILE AND SERVE AN AMENDED NOTICE OF OPPOSITION WITHIN THIRTY DAYS FAILING WHICH THIS OPPOSITON WILL BE DISMISSED

As discussed previously, when we look to the pleadings as we must to determine what issues are pleaded and what issues are subject to summary judgment, opposer's notice of opposition is legally insufficient. Opposer has failed to allege likelihood of confusion as to the marks or the source of the involved goods, as well as priority, both of which are required for a proper

[8] These are not necessarily the only issues remaining for trial.

[9] Evidence submitted in connection with a motion for summary judgment is of record only for purposes of that motion. If the summary judgment is denied and the case goes to trial, the summary judgment evidence does not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate trial period. *See, e.g., Levi Strauss & Co. v. R. Josephs Sportswear In*c., 28 USPQ2d 1464 (TTAB 1993). See also TBMP §528.05(a).

pleading of likelihood of confusion under Section 2(d) of the Trademark Act. See Trademark Rule 2.104(a). See also, Fed. R. Civ. P. 8(a) and (e).

Opposer asserts that both Reg. Nos. 1,008,947 and 2,558,737 are owned by its subsidiary company, Recoton Audio Corporation. See Kennedy Affidavit, paragraph 2. However, the USPTO records, as evidenced by the certified status and title copies submitted as Exhibits A and B to opposer's summary judgment motion, indicate that Reg. No. 1,008,947 is owned by Recoton Audio Corporation, a Delaware corporation, and that Reg. 2,558,737 is owned by opposer, Recoton Corporation, a New York corporation.

If there has been any transfer of interest in either registration that has not been filed with the Office's Assignment Branch, we strongly suggest that the change in ownership be recorded to ensure accuracy of the USPTO's records. Additionally, when opposer files its amended notice of opposition, as ordered herein, it should clearly state which U.S. registration(s) it is asserting, and if it is asserting Reg. No. 1,008,947 with respect to its likelihood of confusion claim, who owns the registration. Also, opposer should clearly explain if it is claiming rights through a subsidiary.

In view of the above, opposer is ordered to file and serve, within thirty days from the mailing date set forth on page one hereof, an amended notice of opposition that complies with the guidance of the Board as explained herein, failing which the opposition will be dismissed with prejudice.

To the extent that opposer asserts rights through its subsidiary's use of the ADVENT mark and that opposer is entitled to rely on registrations owned by its subsidiary, the Board would entertain a motion, by either party, to join Recoton Audio Corporation as a party plaintiff in this proceeding. See Fed. R. Civ. P. 17(a), 19(a), and 25(c). See also TBMP §512 *et seq.* See Trademark Rules 2.6(a)(17) and 2.101(d)(3) regarding the fee therefor.

Except to the extent that an amended pleading is required from opposer as indicated above, proceedings herein are otherwise suspended until further written notice by the Board. Upon resumption, the Board will reset the time for applicant to file an answer to the amended notice of opposition, as well as trial and briefing dates.

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